REMARKS

The following remarks are fully and completely responsive to the Office Action dated March 26, 2004. Claims 1-2 and 4-16 are pending in this application. In the outstanding Office Action claim 1 was rejected under 35 U.S.C. § 112 second paragraph and claims 1-2 and 4-16 were rejected under 35 USC §103(a). Claims 1-2 and 4-16 are presented for consideration.

35 U.S.C. §112 second paragraph

Claim 1 was rejected under 35 U.S.C. §112 second paragraph for failing to provide antecedent basis for "said electronic mail" in line 2 of the claim. Applicants amendment of claim 1 overcomes this rejection by amending "said electronic mail" to "an electronic mail". Therefore, Applicants request reconsideration and withdrawal of this rejection.

35 USC §103(a)

Claims 1-2 and 4-16 were rejected under 35 USC §103(a) as being unpatentable over Ran et al. (U.S. Patent No. 6,209,026, "Ran") in view of DeLorme et al. (U.S. Patent No. 5,559,707). In making this rejection, the Office Action asserted that Ran discloses all the elements of the claimed invention, except for teaching that the information may be coordinate data (claim 4). DeLorme was cited for disclosing this limitation. The Office Action also asserted that it would be obvious to one of ordinary skill in the art to combine these two references. Applicant's request reconsideration of this rejection.

The Office Action admits that Ran fails to explicitly disclose the use of a text input, extracting, adding, and displaying means (Office Action, page 3, lines 7-8). The Office Action asserts that "it is obvious that Ram's invention performs these functions ....because Ran's inventions would not work without them" (Office Action, page 3, lines 8-10). Applicants disagree.

Independent claims 1, 11, and 13, recite in part:

an extracting means for extracting a character string specifying a place from said text of said electronic mail inputted by said text input means;

This claim element is a means-plus-function claim element under 35 U.S.C. §112, sixth paragraph. According to MPEP §§ 2182-2184, a proper prior art rejection must teach the function recited in the claim and must teach the same or equivalent structure disclosed in the present specification to accomplish the recited function. Therefore, the prior art must teach the function of "extracting a character string to specify a place from the text of said electronic mail input by the text input means."

Ran's invention does not disclose, suggest or imply the extracting function because Ran requires the user to fill out a form to receive information. The user fills in the form to select the information the user wants to receive. Specifically, Ran beginning at column 8, line 43 discloses:

> Then, said user could use one or several of the following individual means and procedures to receive personalized real-time traveler information and warning.
>
> (1) Fill or revise information/warning request forms and request a universal user ID and password for all individual means for receiving information and warning via the following procedures (skip this step if said user has completed the forms and does not need to revise):
>
> 1a) .... by using an internet software server as follows: ...., going to said software's various request forms ..., selecting a request form on said

software, inputting the desired functional items/requests and information update frequency in the request form as default, sending completed forms, completing registration forms if being a first-time user,

1b) .... by using a webpage server as follows: starting a web navigator or communicator, going to said host webpage with various request forms ..., selecting a request form on said host webpage, inputting the desired functional items/requests and information update frequency in the request form as default, completing registration forms if being a first-time user

1c) .... by using an email server as follows: starting an email software, sending a request email to said email host ..., receiving a request form from said email host, inputting the desired functional items/requests and information update frequency in the request form as default, sending completed request form to said email host, completing registration forms if being a first-time user

1d) .... by using a gopher server as follows: ... going to said gopher host with various request forms ..., selecting a request form on said gopher host, inputting the desired functional items/requests and information update frequency in the request form as default, completing registration forms if being a first-time user,

1e) .... by using a centralizedfax server as follows: ..., selecting and receiving an empty request form ..., inputting the desired functional items/requests in the request form as default, completing registration forms if being a first-time user, and sending out completed request forms to said fax server,

1f) .... by using a centralized phone server as follows: ..., selecting an empty request form ..., inputting the desired functional items/requests in the request form via digital choices as default, completing registration forms if being a first-time user,

1g) .... by using a centralized server as follows: ... filling request forms for pager company or host server by regular mail or at host specified sites, and

1h) the personalized information providing procedure of an internet in-vehicle navigation device by using a centralized server as follows: using any of the procedures as stated in procedures 1a)-1f); or filling request forms for information service providing company or host server by regular mail or at host specified sites; or starting internet in-vehicle navigation device, finding request forms for personalized real-time traveler information, selecting a request form, inputting the desired functional

items/requests in the request form as default, completing registration forms if being a first-time user, ...

Ran, col. 8, line 43 – col. 9, line 60.

As shown above, regardless of how the information is requested, the user must fill in a form that is either on the server or sent to the server. When email is used the form is attached to the email. Therefore, Ran's invention functions without "extracting a character string specifying a place from said text of said electronic mail inputted by said text input means," since the information is provided on a preformatted form. Accordingly, Ran fails to teach or imply the function of "extracting a character string specifying a place from said text of said electronic mail inputted by said text input means." Thus, Ran fails to teach the function of "extracting a character string specifying a place from said text of said electronic mail inputted by said text input means." Consequently, Ran fails to teach and/or suggest the "extraction means for extracting a character string specifying a place from said text of said electronic mail inputted by said text input means."

Independent claims 1, 11, and 13, further recite in part:

> an adding means for adding information to said electronic mail, said information corresponding to said place specified by said extracted character string.

Independent claims 6 and 14 recite in part:

> an adding means for adding information to said electronic mail, said information corresponding to said specified place.

These claim elements are also means-plus-function claim elements under 35 U.S.C. §112, sixth paragraph. According to MPEP §§ 2182-2184, a proper prior art rejection must teach the function recited in the claim and must teach the same or

equivalent structure disclosed in the present specification to accomplish the recited function. Therefore, the prior art must teach the function of "adding information to said electronic mail, said information corresponding to said place specified by said extracted character string" or the function of "adding information to said electronic mail, said information corresponding to said specified place."

Regarding claims 1, 11, and 13, Ran fails to teach and/or suggest "extracting a character string specifying a place from said text of said electronic mail." Consequently, Ran can not perform the function of "adding information to said electronic mail, said information corresponding to said place specified by said extracted character string."

In fact Ran does not add any information to an existing email. Instead, the user in Ran receives information from the server as described beginning at column 9, line 64:

> (2) Receive personalized real-time traveler information via the following procedures (if said user expects to receive abnormal travel condition warning only, skip this step and going to Step (3) directly):
>
> 2a) ... by using an internet software server as follows: starting an internet software or client software, going to default forms showing personalized real-time traveler information on said internet software or client software, requesting host processing, receiving and displaying/announcing said desired personalized real-time traveler information on said internet software or client software, ...
>
> 2b) ... by using a webpage server as follows: starting a web navigator or communicator, going to said host webpage, using bookmark or other means to start the default functional items/requests, requesting webpage host processing, displaying/announcing said desired personalized real-time traveler information on the web navigator or communicator, ...
>
> 2c) .... by using an email server as follows: starting an email software, receiving and displaying said desired personalized real-time traveler information in email box based on default functional items/requests and email update frequency,

2d) .... by using a gopher server as follows: starting a gopher software, using bookmark or other means to go to user-specific gopher page, starting the default functional items/requests, requesting gopher host processing, displaying said desired personalized real-time traveler information on the gopher software....

2e) ... by using a centralized fax server as follows: starting said internet fax machine (or regular fax machine) by dialing said fax server number or internet address, requesting host server processing, while the fax host server will identify said user's ID number and password, find said user's information request form and items, process the requested real-time traveler information and sent back the processed personalized real-time traveler information as user-defined default functional items/requests to said user's fax machine over internet (or regular phone line or cellular phone connection),

2f) ... by using a centralized phone server as follows: starting said internet phone (or regular phone or cellular phone) by dialing said phone server number or internet address, requesting host server processing, while the phone host server will identify said user's ID number and password, find said user's information request form and items, process the requested real-time traveler information and read the processed personalized real-time traveler information as user-defined default functional items/requests to said user's internet phone or regular phone or cellular phone

2g) ... by using a centralized pager server or hand-held device server as follows: starting said pager or hand-held device by dialing said server number or internet address, requesting host server processing, while the pager or hand-held device host server will identify said user's ID number and password, find said user's information request form and items, process the requested real-time traveler information and send back the processed personalized real-time traveler information as user-defined default functional items/requests to said user's internet pager or hand-held devices, showing/reading/printing the desired personalized real-time traveler information on the internet pager or hand-held devices,

2h) .... by using a centralized vehicle navigation server as follows: starting an internet-based in-vehicle navigation device, requesting internet in-vehicle navigation host processing, while the internet in-vehicle navigation host server will identify said user's ID number and password, find said user's information request form and items, will process the requested real-time traveler information and sent back the processed personalized real-time traveler information to said user's internet in-vehicle navigation device, showing/announcing the desired personalized real-time traveler information on the internet in-vehicle navigation device.

Ran, col. 9 line 64 – col. 12, line 16.

As described above, Ran does not add anything to an existing communication. The server in Ran only creates an email or other communication that is sent to a user. Thus, Ran's invention does not need to add anything to an email or other communication to function.

Regarding claims 1, 11, and 13, Ran fails to imply or teach the function of "adding information to said electronic mail, said information corresponding to said place specified by said extracted character string." Accordingly, Ran fails to disclose and/or suggest the recited "adding means for adding information to said electronic mail, said information corresponding to said place specified by said extracted character string."

Regarding claims 6 and 14, Ran fails to imply or teach the function of "adding information to said electronic mail, said information corresponding to said specified place." Accordingly, Ran fails to disclose and/or suggest the recited "adding means for adding information to said electronic mail, said information corresponding to said specified place."

The independent claims each recite in part:

a route guidance means providing a route guidance instruction based on the information added to the electronic mail.

This claim element is also means-plus-function claim element under 35 U.S.C. § 112, sixth paragraph. According to MPEP §§ 2182-2184, a proper prior art rejection must teach and function recited in the claim and must teach the same or equivalent structure disclosed in the present specification to accomplish the recited function.

Therefore, the prior art must teach the function "providing a route guidance instruction based on the information added to the electronic mail."

However, as discussed above, Ran fails to disclose and/or suggest the extracting means and the adding means of the present invention. Since Ran does not add information to the email, Ran can not provide a route guidance instruction based on the information added to the email.

Consequently, Ran fails to teach the function of "providing a route guidance instruction based on the information added to the electronic mail." Therefore, Ran fails to teach and/or suggest the recited "route guidance means for providing a route guidance instruction based on the information added to the electronic mail."

DeLorme is not cited for, nor does this DeLorme teach and/or suggest the recited extracting means, adding means, and route guidance means. Consequently, the combination of Ran and DeLorme fail to teach and/or suggest the claimed invention.

Regarding claims 1, 11, and 13, and the claims dependent thereon, the combination of Ran and DeLorme fails to teach the function of "extracting a character string specifying a place from said text of said electronic mail inputted by said text input means." Accordingly, these references fail to teach and/or suggest "an extracting means for extracting a character string specifying a place from said text of said electronic mail inputted by said text input means."

These references also fail to teach the function of adding information to the electronic mail the information corresponding to the place specified by the extracted character string. Therefore, these references fail to teach and/or suggest "an adding

means for adding information to the electronic mail, the information corresponding to the place specified by the extracted character string."

These references also fail to teach the function of "displaying map information indicating the specified place corresponding to the information added to the electronic mail." Therefore, these references fail to teach and/or suggest "a map display means for displaying map information indicating the specified place corresponding to the information added to the electronic mail."

These references also fail to teach the function of providing a route guidance instruction based on said information added to said electronic mail. Therefore, these references fail to teach and/or suggest a route guidance means for providing a route guidance instruction based on said information added to said electronic mail.

Regarding claims 6 and 14, and the claims dependent thereon, the combination of Ran and DeLorme fail to teach the function of adding information to said electronic mail, said information corresponding to said specified place. Therefore, these references fail to teach and/or suggest "an adding means for adding information to said electronic mail, said information corresponding to said specified place."

These references also fail to teach the function of "displaying map information indicating said specified place corresponding to said information added to said electronic mail." Therefore these references fail to teach and/or suggest "a map display means for displaying map information indicating the specified place corresponding to the information added to the electronic mail."

These references also fail to teach the function of "providing a route guidance instruction based on said information added to said electronic mail." Therefore, these

references fail to teach and/or suggest "a route guidance means for providing a route guidance instruction based on said information added to said electronic mail."

Since the combination of Ran and DeLorme fails to teach and/or suggest the claimed invention, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 2 and 4-16 under 35 U.S.C. §103(a).

Conclusion

Applicants' remarks have overcome the rejections set forth in the Office Action dated March 26, 2004. Specifically, Applicants' amendment of claim 1 overcomes the rejection of this claim under 35 U.S.C. § 112, second paragraph. Applicants' remarks have distinguished the claimed invention from the cited prior art and thus overcome the rejection of claims 1-2 and 4-16 under 35 U.S.C. §103(a). Therefore, Applicants respectfully request reconsideration and allowance of claims 1-2 and 4-16.

Applicants submit that the application is now in condition for allowance. If the Examiner believes that the application is not in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned Attorney by telephone, if it is believed that such contact will expedite the prosecution of the application.

In the event that this paper is not considered to be timely filed, Applicants respectfully petition for an appropriate extension of time. The Commissioner is authorized to charge payment of any additional fee which may be required with respect to this paper to Deposit Account No. 01-2300, making reference to Attorney Docket No. 107439-08005.

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